

Application No.: 09/932,910
Response dated: February 17, 2004
Reply to Office Action of November 17, 2003

REMARKS

Reconsideration of the present claims, in light of the attached claim clarifications and the Remarks, which follow, is respectfully requested.

Claims now before the Examiner are 1-2, 4-13, and 15-36.

The numbering in this response will follow that of the Examiner's Action of November 17, 2003.

1. & 2. No response necessary.

Rejections Under 35 USC § 112, second paragraph

3. *Claims 1, 7 and 29 stand rejected under 35 USC § 112, Second Paragraph*

Applicants respectfully submit that the amended claims 1, 7 and 29 address this Rejection.

4. *Claims 1, 2, 4-13 and 15-36 stand rejected under 35 USC § 112, Second Paragraph*

The Examiner states that the provisos added in the last response were new matter. Applicants respectfully disagree. The citation pointed to by the Examiner, *In re Grasselli* 231 USPQ 390, 393, is woefully short of detail, save for the admonition "...the negative limitations recited in the present claims, which did not appear in the specification as filed, introduce new concepts and violate the description requirement of the first paragraph of 35 U.S.C. 112...". The reader has no idea of what was originally disclosed. Applicants believe that a more relevant case is *In re Johnson* 194 USPQ 187 (CCPA, 1977). In this citation, as in the present case, Applicants disclosed a genus. The court held that (citing an earlier decision *In re Saunders* 170 USPQ 213, 220 (1971)) " Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable. It is for the inventor to decide what bounds of protection he will seek. ... To deny appellants the benefit of their.... Application in this case would... let

1998U020A.D1.US.111.02.17.04

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form triumph over substance, substantially eliminating the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was first with the genus when he filed." The analogy with the present case is as follows:

Applicants disclosed metals of Groups 3-10, among which is Tungsten. Among the references cited by the Examiner is one using Tungsten, so if Applicants originally disclosed the metal, they can decide that that embodiment is no longer available to them and exclude it from the claims. Likewise, the exclusion of Oxygen as a heteroatom when the metal is Titanium, is also among the originally disclosed and claimed embodiments, now eliminated as an embodiment to obviate the reference.

Applicants respectfully urge reconsideration based on this line of reasoning.

Withdrawal of the Rejections is respectfully requested.

All of the Examiner's Rejections have been addressed.

The claims are in condition for allowance.

1998U020A.D1.US.111.02.17.04

- 12 -

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SOUTHWEST PATENT SVS

PAGE 02/02

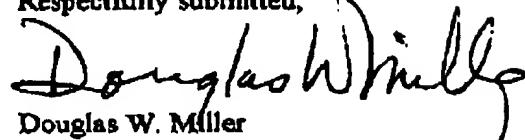
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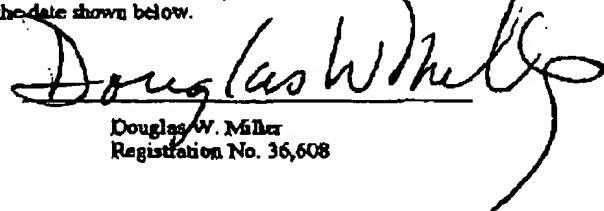
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